UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,825	12/24/2003	Akira Kinno	247194US8X	1141

22850 7590 03/14/2008		

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ART UNIT	PAPER NUMBER
2176	

NOTIFICATION DATE	DELIVERY MODE
03/14/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/743,825</td><td>Applicant(s)
KINNO ET AL.</td></tr>
<tr><td>Examiner
LAURIE RIES</td><td>Art Unit
2176</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 December 2007</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-33</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-33</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>24 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment, filed 26 December

2007, to the Original Application, filed 24 December 2003.

2.   Claims 1-33 are pending. Claims 1, 5, 6, 7, 8, and 9 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Callahan (U.S. Publication 2002/0157023 A1) in view of Sheynblat (U.S. Patent

6,677,894 B2) and Nussbaum (U.S. Patent 6,779,154 B1)

As per independent claim 1, Callahan teaches an apparatus for converting a

structured document (See Callahan, Figure 6, and Pages 4-5, paragraph 0065)

comprising acquiring means for acquiring distribution rule information sent from a

remote source when data contents are sent to a distribution means (See Callahan,

Figure 3, elements 308a, b, and c), including rules as to who may receive and view a

particular file, which describe contents rules and receiver side situation information, such as a patient's assigned physician, etc (See Callahan, Page 3, paragraphs 0052-0054, and Page 5, paragraphs 0071-0072).

Callahan also teaches generation means for generating conversion rule information for converting structured documents with described content where the converting rules are based on the receiver side situation information previously acquired (See Callahan, Page 6, paragraphs 0074-0075 and paragraphs 0081-0082).

Callahan also teaches conversion means for converting the structured documents on the basis of the conversion rule information (See Callahan, Page 6, paragraph 0083) and storing the structured documents in a computer readable memory for subsequent retrieval (See Callahan, Figure 3, element 306).

Callahan also teaches that the generation means includes a first extraction means for extracting evaluation objects of the conditions included in the distribution rules from the distribution rule information (See Callahan, Page 6, paragraph 0081).

Callahan does not teach expressly that the converting rules are based upon distribution rule information in addition to the receiver side situation information.

Sheynblat teaches that information may be sent based on distribution rules that include a user's location and the like (See Sheynblat, Column 20, lines 15-26).

Callaghan also does not teach expressly that the conversion of the structured documents does not include an intermediate conversion of the structured documents.

Nussbaum teaches converting a structured document directly into another structured document, such as converting an XML document directly into an HTML document (See Nussbaum, Figure 1, and Column 4, lines 22-30)

Callahan, Sheynblat, and Nussbaum are analogous art because they are from the same field of endeavor of transmitting structured information across a network, such as the Internet.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the distribution rule information of Sheynblat in the generation of converting rules of Callahan. The motivation for this would have been to allow for the inclusion of targeted marketing, billing, etc, based on a customer's location (See Sheynblat, Column 20, lines 26-31).

At the time of the invention it would also have been obvious to one of ordinary skill in the art to include the direct conversion from one structured document to another of Nussbaum with the conversion rule information of Callaghan. The motivation for doing so would have been to preserve the original structured document such that the new document may be easily converted back for future analysis (See Nussbaum, Column 9, lines 4-16)

Therefore it would have been obvious to combine Sheynblat and Nussbaum with Callahan for the benefit of allowing for the inclusion of targeted marketing, billing, etc, based on a customer's location, and preserving the original structured document such that the new document may be easily converted back for future analysis, to obtain the invention as specified in claim1.

As per dependent claim 2, Callahan, Sheynblat, and Nussbaum teach the limitations of claim 1 as described above. Callahan also teaches a second extraction means for extracting the receiver side situation corresponding to the evaluation object from the receiver side situation information on the basis of the evaluation objects extracted by the first extraction means (See Callahan, Page 6, paragraph 0081). Callahan also teaches evaluation means for evaluating the conditions on the basis of the receiver side situation information extracted by the second extraction and on the basis of the results of the evaluation on the conversion rules information (See Callahan, Page 6, paragraph 0081).

As per dependent claim 3, Callahan, Sheynblat, and Nussbaum teach the limitations of claim 2 as described above. Callahan also teaches that when the evaluation is a negative evaluation, such as excluding some physicians from viewing a patient's medical test record, generating the conversion rule information to delete objects corresponding to the conditions under which the evaluation has been performed from the structured document (See Callahan, Page 6, paragraph 0082).

As per dependent claim 4, Callahan, Sheynblat, and Nussbaum teach the limitations of claim 2 as described above. Callahan also teaches a memory for storing the conversion rule information as created in claim 2 (See Callahan, Page 6, paragraph 0073, and Figure 1, element 106).

As per independent claim 5, Callahan teaches a computer-implemented method for converting a structured document (See Callahan, Figure 6, and Pages 4-5, paragraph 0065). Independent claim 5 additionally incorporates substantially similar

subject matter as that of independent claim 1 above, and is additionally rejected along the same rationale as used in the rejection of claim 1.

As per independent claim 6, Callahan teaches a computer readable medium having computer program instructions encoded thereon that implement functions for converting a structured document (See Callahan, Figure 6, and Pages 4-5, paragraph 0065). Independent claim 6 additionally incorporates substantially similar subject matter as that of independent claim 1 above, and is additionally rejected along the same rationale as used in the rejection of claim 1.

As per independent claim 7, Callahan teaches an apparatus for converting a structured document (See Callahan, Figure 6, and Pages 4-5, paragraph 0065) comprising acquisition means for acquiring distribution rule information wherein distribution rules of contents are described and receiver side situation information wherein the situations at the side of receivers of the contents are described, such as a patient's assigned physician, etc (See Callahan, Page 3, paragraphs 0052-0054, and Page 5, paragraphs 0071-0072).

Callahan also teaches generation means for generating the conversion rule information wherein the conversion rules for converting structured documents in which information about the contents is described (See Callahan, Page 6, paragraphs 0074-0075 and paragraphs 0081-0082).

Callahan also teaches conversion means for converting structured documents, on the basis of the conversion rule information generated by the generation means (See Callahan, Page 6, paragraph 0083).

Callahan also teaches that the generation means comprises: a first extraction means for extracting evaluation objects of the conditions included in the distribution rules from the distribution rule information (See Callahan, Page 6, paragraph 0081), a second extraction means for extracting the receiver side situation corresponding to the evaluation object from the receiver side situation information on the basis of the evaluation objects extracted by the first extraction means (See Callahan, Page 6, paragraph 0081), and evaluation means for evaluating the conditions on the basis of the receiver side situation extracted by the second extraction means, and on the basis of the results of the evaluation performed by the evaluation means, the conversion rule information is generated (See Callahan, Page 6, paragraph 0081).

Callahan does not teach expressly that the converting rules are based upon distribution rule information in addition to the receiver side situation information.

Sheynblat teaches that information may be sent based on distribution rules that include a user's location and the like (See Sheynblat, Column 20, lines 15-26).

Callahan also does not teach expressly that the conversion of the structured documents does not include an intermediate conversion of the structured documents.

Nussbaum teaches converting a structured document directly into another structured document, such as converting an XML document directly into an HTML document (See Nussbaum, Figure 1, and Column 4, lines 22-30)

Callahan, Sheynblat, and Nussbaum are analogous art because they are from the same field of endeavor of transmitting structured information across a network, such as the Internet.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the distribution rule information of Sheynblat in the generation of converting rules of Callahan. The motivation for this would have been to allow for the inclusion of targeted marketing, billing, etc, based on a customer's location (See Sheynblat, Column 20, lines 26-31).

At the time of the invention it would also have been obvious to one of ordinary skill in the art to include the direct conversion from one structured document to another of Nussbaum with the conversion rule information of Callaghan. The motivation for doing so would have been to preserve the original structured document such that the new document may be easily converted back for future analysis (See Nussbaum, Column 9, lines 4-16)

Therefore it would have been obvious to combine Sheynblat and Nussbaum with Callahan for the benefit of allowing for the inclusion of targeted marketing, billing, etc, based on a customer's location, and preserving the original structured document such that the new document may be easily converted back for future analysis, to obtain the invention as specified in claim 7.

As per independent claim 8, Callahan teaches a method for converting a structured document (See Callahan, Figure 6, and Pages 4-5, paragraph 0065). Callahan also teaches outputting the converted documents to a distribution server (See Callahan, Figure 5, element 516, and Page 4, paragraph 0061). Independent claim 8 additionally incorporates substantially similar subject matter as that of independent

claim 7 above, and is additionally rejected along the same rationale as used in the

rejection of claim 7.

As per independent claim 9, Callahan teaches a computer readable medium

having computer program instructions encoded thereon that implement functions for

converting a structured document (See Callahan, Figure 6, and Pages 4-5, paragraph

0065). Independent claim 9 additionally incorporates substantially similar subject matter

as that of independent claim 7 above, and is additionally rejected along the same

rationale as used in the rejection of claim 7.

As per dependent claim 10, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 1 as described above. Callahan also teaches that information

regarding the contents of the structured documents is described in each of the

evaluation objects (See Callahan, Page 6, paragraph 0074, teaching stylesheets that

describe the document content).

As per dependent claim 11, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 1 as described above. Callahan also teaches that the conversion

means judges from information of the structured documents described in each of the

objects whether access control is performable to convert or select the accessible object

on the basis of the conversion rule information generated by the generation means (See

Callahan, Page 5, paragraphs 0069-0071, teaching that information, such as the data

content and user roles, is used to determine whether to convert or select the objects

based on various access rules).

As per dependent claim 12, Callahan, Sheynblat and Nussbaum teach the limitations of claim 1 as described above. Callahan also teaches access control means for judging whether to grant access on either a keyword or value basis (See Callahan, Page 5, paragraphs 0069-0071, teaching that access is based on values included in user roles and data content).

As per dependent claim 13, Callahan, Sheynblat and Nussbaum teach the limitations of claim 1 as described above. Callahan also teaches that information regarding the contents of the structured documents is described in each of the evaluation objects (See Callahan, Page 6, paragraph 0074, teaching stylesheets that describe the document content), the conversion means judges from information of the structured documents described in each of the objects whether access control is performable to convert or select the accessible object on the basis of the conversion rule information generated by the generation means (See Callahan, Page 5, paragraphs 0069-0071, teaching that information, such as the data content and user roles, is used to determine whether to convert or select the objects based on various access rules), and evaluating the conditions on the basis of the receiver side situation extracted by the second extraction, and on the basis of the results of the evaluation on the conversion rules information (See Callahan, Page 6, paragraph 0081), and also including access control means, for judging whether to grant access on either a keyword or value basis(See Callahan, Page 5, paragraphs 0069-0071, teaching that access is based on values included in user roles and data content).

As per dependent claim 14, Callahan, Sheynblat and Nussbaum teach the limitations of claim 5 as described above. Claim 14 additionally incorporates substantially similar subject matter as that of claim 10 above, and is additionally rejected along the same rationale as used in the rejection of claim 10.

As per dependent claim 15, Callahan, Sheynblat and Nussbaum teach the limitations of claim 5 as described above. Claim 15 additionally incorporates substantially similar subject matter as that of claim 11 above, and is additionally rejected along the same rationale as used in the rejection of claim 11.

As per dependent claim 16, Callahan, Sheynblat and Nussbaum teach the limitations of claim 5 as described above. Claim 16 additionally incorporates substantially similar subject matter as that of claim 12 above, and is additionally rejected along the same rationale as used in the rejection of claim 12.

As per dependent claim 17, Callahan, Sheynblat and Nussbaum teach the limitations of claim 5 as described above. Claim 17 additionally incorporates substantially similar subject matter as that of claim 13 above, and is additionally rejected along the same rationale as used in the rejection of claim 13.

As per dependent claim 18, Callahan, Sheynblat and Nussbaum teach the limitations of claim 6 as described above. Claim 18 additionally incorporates substantially similar subject matter as that of claim 10 above, and is additionally rejected along the same rationale as used in the rejection of claim 10.

As per dependent claim 19, Callahan, Sheynblat and Nussbaum teach the limitations of claim 6 as described above. Claim 19 additionally incorporates

substantially similar subject matter as that of claim 11 above, and is additionally rejected along the same rationale as used in the rejection of claim 11.

As per dependent claim 20, Callahan, Sheynblat and Nussbaum teach the limitations of claim 6 as described above. Claim 20 additionally incorporates substantially similar subject matter as that of claim 12 above, and is additionally rejected along the same rationale as used in the rejection of claim 12.

As per dependent claim 21, Callahan, Sheynblat and Nussbaum teach the limitations of claim 6 as described above. Claim 21 additionally incorporates substantially similar subject matter as that of claim 13 above, and is additionally rejected along the same rationale as used in the rejection of claim 13.

As per dependent claim 22, Callahan, Sheynblat and Nussbaum teach the limitations of claim 7 as described above. Claim 22 additionally incorporates substantially similar subject matter as that of claim 10 above, and is additionally rejected along the same rationale as used in the rejection of claim 10.

As per dependent claim 23, Callahan, Sheynblat and Nussbaum teach the limitations of claim 7 as described above. Claim 23 additionally incorporates substantially similar subject matter as that of claim 11 above, and is additionally rejected along the same rationale as used in the rejection of claim 11.

As per dependent claim 24, Callahan, Sheynblat and Nussbaum teach the limitations of claim 7 as described above. Claim 24 additionally incorporates substantially similar subject matter as that of claim 12 above, and is additionally rejected along the same rationale as used in the rejection of claim 12.

As per dependent claim 25, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 7 as described above. Claim 25 additionally incorporates

substantially similar subject matter as that of claim 13 above, and is additionally rejected

along the same rationale as used in the rejection of claim 13.

As per dependent claim 26, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 8 as described above. Claim 26 additionally incorporates

substantially similar subject matter as that of claim 10 above, and is additionally rejected

along the same rationale as used in the rejection of claim 10.

As per dependent claim 27, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 8 as described above. Claim 27 additionally incorporates

substantially similar subject matter as that of claim 11 above, and is additionally rejected

along the same rationale as used in the rejection of claim 11.

As per dependent claim 28, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 8 as described above. Claim 28 additionally incorporates

substantially similar subject matter as that of claim 12 above, and is additionally rejected

along the same rationale as used in the rejection of claim 12.

As per dependent claim 29, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 8 as described above. Claim 29 additionally incorporates

substantially similar subject matter as that of claim 13 above, and is additionally rejected

along the same rationale as used in the rejection of claim 13.

As per dependent claim 30, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 9 as described above. Claim 30 additionally incorporates

substantially similar subject matter as that of claim 10 above, and is additionally rejected

along the same rationale as used in the rejection of claim 10.

As per dependent claim 31, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 9 as described above. Claim 31 additionally incorporates

substantially similar subject matter as that of claim 11 above, and is additionally rejected

along the same rationale as used in the rejection of claim 11.

As per dependent claim 32, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 9 as described above. Claim 32 additionally incorporates

substantially similar subject matter as that of claim 12 above, and is additionally rejected

along the same rationale as used in the rejection of claim 12.

As per dependent claim 33, Callahan, Sheynblat and Nussbaum teach the

limitations of claim 9 as described above. Claim 33 additionally incorporates

substantially similar subject matter as that of claim 13 above, and is additionally rejected

along the same rationale as used in the rejection of claim 13.

Response to Arguments

4.   Applicant's arguments filed 26 December 2007 have been fully considered but

they are not persuasive.

Applicant argues that the teachings of Nussbaum, namely converting a

structured document directly into another structured document, would change the

principle of operation of Callahan because Callahan includes a step of creating an

annotated, intermediate file. The Office respectfully disagrees. As stated in Callahan,

"The semantic firewall **can** be configured to perform multi-stage XML and HTML

transformations as a server-based HTTP proxy. In an exemplary embodiment, the

transformation **can** take place in three stages" (Emphasis added, See Callahan, Page

4, paragraph 0060). There is no teaching in Callahan that concludes the transformation

must be performed by incorporating the intermediate step. Furthermore, Callahan

states that "While various embodiments of the present invention have been described

above, it should be understood that they have been presented by way of example only,

and not limitation" (See Callahan, Page 8, paragraph 0104). Per the MPEP, Section

2143.02, a rationale to support a conclusion that a claim would have been obvious is

that all the claimed elements were known in the prior art and one skilled in the art could

have combined the elements as claimed by known methods with no change in their

respective functions, and the combination would have yielded nothing more than

predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex*

Inc., 550 U.S. ___, ___, 82 USPQ2d obv1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*,

425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc v.*

Pavement Salvage Co., 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic*

& P. Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152, 87 USPQ 303, 306

(1950). In this case, including the known method of a direct conversion of a structured

document into another structured document, as taught by Nussbaum, with the

conversion rule information of Callahan, in order to produce the predictable result of a

new structured document, would have been obvious to one of ordinary skill in the art at

the time of the invention, providing the benefit of preserving the original structured

document such that the new document may be easily converted back for future

analysis.

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton, can be reached on (571) 272-4137.

7.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laurie Ries/
Laurie Ries
Patent Examiner
Technology Center 2100
5 March 2008